UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,909	12/28/1999	RICHARD D. MARRY	E-954	2919

919 7590 07/30/2004		

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER
NGUYEN, TAN D

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Advisory Action	09/474,909	MARRY ET AL.
	Examiner	**Art Unit**
	Tan Dean D. Nguyen	3629

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<u>PERIOD FOR REPLY</u> [check either a) or b)]

a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on <u>04 June 2004.</u> Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet.*

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.
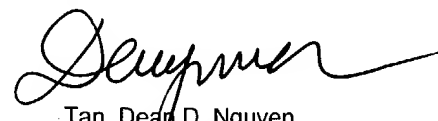
    Claim(s) objected to: _____.

    Claim(s) rejected: *1-3.*

    Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Tan Dean D. Nguyen
Primary Examiner
Art Unit: 3629

Continuation of 5. does NOT place the application in condition for allowance because:
1) Applicant's comment that the Finality of the office action is improper because the amendment was immaterial is not persuasive in view of the amendment on step (a) "and addressee information" and (d) "and said determined type of mailpiece" of the previous Amendment which are pertinent to the claim and to the examination process which require new searches and rejections.
2) Applicant's comment that the teachings of Article '1998 and '1995 fails to teach attributing sorting costs to specific addressees having mailpieces processed in a common incoming sorting apparatus or steps (d) and (e) is not persuasive in view of the rejection as shown in claim 1 when combining Article '1995 into '1998 and with the teaching of '1995 of "passing the cost savings to qualifying mailers" which would make it obvious to establish piece count for each corresponding addressee information to keep track of sorting cost for the qualifying mailer in order to achieve the goal of passing the cost savings to them properly.

Note that as the examiner further reviews the application, especially Fig. 3 and specification, page 7, lines 3-6, it appears that after step (d) [Fig. 3 (128)] and before step (e) [Fig. 3 (136)], the step of [(134) or page 7, lines 5-6] is critical and must be inputted to the computer system in order to perform step (e). If this true, then the examiner recommends the filing of an RCE and add this new limitation into claim 1 and to properly allow sufficient time to exam the case properly again.